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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/481,988	01/11/2000	PAUL J. BRUINSMA	1941-70	6422

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EXAMINER	
MARCANTONI, PAUL D	
ART UNIT	PAPER NUMBER
1755	

37

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/481,988	Applicant(s) BRUINSMA et al.
	Examiner Paul Marcantoni	Group Art Unit 1755

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on 9/24/03.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☑ Claim(s) 129-189 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☑ Claim(s) 129-187 is/are allowed.

☑ Claim(s) 188 & 189 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

Applicant's arguments filed 9/24/03 have been fully considered but they are not fully persuasive. Applicants addition of new claim 189 necessitated rejection regarding recapture over this product by process claim.

Allowed Claims:

Process claims 129-187 are allowable.

Improper Presentation of Product Claims 188 and 189:

Claims 188 and *now new claim 189* is rejected under 35 USC 251 as being an improper recapture of the claimed subject matter deliberately canceled in the application for the patent upon which the present re-issue is based and a reissue applicant's failure to file a divisional application is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by re-issue of the original patent under 35 USC 251. In re Watkinson, 900 F2d 230, 14 USPQ2d 1407 (Fed Cir. 1990); In re Orita, 550 F2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977) See also In re Mead, 581 F2d 251, 198 USPQ 412 (CCPA 1978) See MPEP 1450-51. Cancellation of claim 188 is thus requested.

Improper Amendment submitted 4/14/03 adding new claims 129-188

The amendment submitted April 14, 2003 is not in accordance with 37 CFR 1.173 (d). Specifically, the newly presented claims have not been underlined in their entirety. All markings should be done relative to the claims in the patent. Please see MPEP 1453. Also, note that 37 CFR 1.173 (c) requires that whenever there is an amendment to the claims, there must also be supplied, on pages separate from the pages containing the changes, an explanation of the support in the disclosure of the patent for the changes made to the claims. Applicants can resolve this easily for all original claims by identifying which claim corresponds to the original claims and further

for the new claims to explain where they derive support for these new claims from their original disclosure. This has been requested to ascertain that applicants have complied with rule 37 CFR 1.173 (c).

In response to this issue, applicants have underlined the previously new claims 129-188. In the 9/24/03 response and amendment, the applicants now present new claim 189 to a calcined mesoporous silica film on a substrate. The amendment is now proper.

Supplemental Reissue Oath/Declaration Required:

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. (See also MPEP 1444 and 1414.01)

Applicants have submitted a supplemental re-issue oath and have satisfied this request in their 9/24/03 response.

Consent of Assignee for Re-issue:

This application is objected to under 37 CFR 1.172(a) as lacking the written consent of all assignees owning an undivided interest in the patent. The consent of the assignee must be in compliance with 37 CFR 1.172. See MPEP § 1410.01.
A proper assent of the assignee in compliance with 37 CFR 1.172 and 3.73 is required in reply to this Office action.

Applicants have satisfied this requirement also.

Missing Information Disclosure Statement:

It would be appreciated if applicants can send copies of all their information disclosure statements (which was submitted on January 11, 2000). These copies are missing so please send copies that were previously submitted.

Response to Arguments regarding Product Claims 188 and now 189:

The applicants argue that they are not trying to revive the subject matter of non-elected claims in the parent application in pending claims 188-189. Applicants argue that claims 188 and 189 are not the same as the subject matter of claims 25-27 and 28 of the parent application. The examiner disagrees. Pending claims 188 and 189 are the same subject matter as originally presented claim 28. All these claims are directed to a *calcined mesoporous silica film on a substrate.*

The applicants argue that claims 188 and 189 are "product by process claims" and this makes the "subject matter" of claims 188 and 189 thus different. In rebuttal, is the product formed in originally presented and non-elected claim 28 any different than the the product of claims 188 and 189? The examiner sees no difference between the products of these three claims because all are directed to a calcined mesoporous silica film on a substrate. This is the same invention of claim 28 (Group III in the examiner's original restriction) which was an invention non-elected by applicants and should have been re-presented in a divisional application but was not.

The applicants also allege that the examiner argues that all product claims are barred from prosecution in a reissue including claims 188 and 189. In rebuttal, the applicants product claims directed to a mesoporous silica powder (claim 25), particles (claim 26), mesoporous silica product (claim 27), and a calcined mesoporous silica film on a substrate (claim 28 and now new claims 188 and 189 which are the same invention) are in fact barred from recapture in a reissue application. The proper route to

obtaining a patent grant on these claims is through a divisional application which was not carried out by applicants. Applicants' claims 188 and 189 correspond directly to non-elected originally presented claim 28 and constitutes recapture and is thus impermissible.

The applicants then make the next point that claims 188 and 189 would allegedly have not have been subject to that restriction requirement because they are product by process claims and would have been part of the elected *process* claims in the original restriction requirement corresponding to Group I. The examiner disagrees. The examiner of the original prosecution is the same as the examiner of the re-issue application and it is noted that claims 188 and 189 most certainly would not have been inserted into Group I directed to the process claims for the restriction. In fact, product by process claims 188 and 189 would have been placed in the same group as claim 28, also directed to a calcined mesoporous silica film on a substrate. Namely, that would have been Group III of the original restriction in the patent application.

The applicants state that a product claim, reciting only a single process limitation can be properly restricted if an alternative method for making that product is stated by the examiner. The applicants argue that a product by process claim, however, reciting a process with particularity, is less likely to be capable of being made by any alternative process. Applicants conclude that such a claim (ie product by process claim) is not properly subject to restriction unless the examiner can offer an alternative method that nevertheless satisifies the ~~claime~~ claimed process steps recited in such a claim. Claims 188

and 189 are stated as representative of those product by process claims alleged to be unrestrictable.

In rebuttal, any product claim is restrictable from the process claims if it can be shown that it can made is the same and can be made by a materially different process. For example, ceramic materials can be made by sol-gel, organometallic synthesis, and solid state sintering and the ceramic material formed in all cases is the same. It is not relevant whether applicants claim the ceramic material as a mere product claim or product by process claim as long as the examiner can show that the product can be made by a different process. The applicants are incorrect in their position that a product by process claim is not restrictable. If the examiner can show that the same product can be made by a different process, the restriction is proper. "Product by Process claims do not patentably distinguish the product of reference even though made by a different process." In re Thorpe , 227 USPQ 964. Thus, product by process claims are as restrictable as any other product claim in accordance with In re Thorpe.

Also, the original restriction was proper. The applicants did not traverse nor attempt in any manner to traverse the original restriction should they have held it to be improper. Applicants did not petition the properness of the restriction either.

Further, the examiner is not required to again restrict the product claims from the process claims since this would result in duplicating that which was done in the parent application. This restriction was already made and claims 188 and 189 are directed to a calcined mesoporous silica film substrate and would fall under Group III (original claim 28 which is also a calcined mesoporous silica film substrate) of the parent application's

restriction requirement. In re Thorpe provides clear support as to why claims 188 and 189 ~~ove~~ even though product by process claim would have been part of Group III including original claim 28 are ~~are~~ not a different invention.

Finally, the examiner has met the burden as shown by the reasons above and is not required to provide a new restriction for the benefit of applicants as it is repeating what was already done in the parent application and applicants had every opportunity if they so desired to file product by process claims in the parent application which they did not do. Again, the reissue applicant's failure to file a divisional application is not considered to be an error causing a patent granted on elected claims to be partially inoperative by reason of claiming less than the applicant had a right to claim. Thus, such error is not correctable by re-issue of the original patent under 35 USC 251. In re Watkinson, 900 F2d 230, 14 USPQ2d 1407 (Fed Cir. 1990); In re Orita, 550 F2d 1277, 1280, 193 USPQ 145, 148 (CCPA 1977) See also In re Mead, 581 F2d 251, 198 USPQ 412 (CCPA 1978) See MPEP 1450-51.Cancellation of product claims 188 and 189 is thus advised.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is (703)-308-1196. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Bell can be reached on (703) 308-3823. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-872-9310 for regular communications and (703)-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.

Paul Marcantoni
Primary Examiner
Art Unit 1755